

## REMARKS

In the Office Action mailed by the United States Patent and Trademark Office on March 6, 2005, the Examiner rejected claims 1, 3, 4, 7-9, 11, and 13 under 35 U.S.C. § 101; rejected claims 1-7, 12-21, 23, and 26-29 under 35 U.S.C. § 102(e) as being anticipated by U.S. Published Pat. App. No. 2002/0082919 ("Landau"); rejected claims 8-10, 22, and 24 under 35 U.S.C. § 103(a) as being unpatentable over Landau; and rejected claims 11 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Landau in view of U.S. Pat. No. 6,477,509 ("Hammons"). Accordingly, Applicants respectfully provide the following:

### Rejections Under 35 U.S.C. § 101

Applicant has amended the claim set to include physical acts to be performed outside the computer independent of and following the steps to be performed by the programmed computer. "A process is statutory if it requires physical acts to be performed outside the computer independent of and following the steps to be performed by the programmed computer, where those acts involve the manipulation of tangible physical objects and result in the object having a different physical attribute or structure." Diamond v. Diehr, 450 U.S. at 187. The claims include the post-computer process steps of personalizing promotional material and distributing the promotional materials directly to customers. These steps result in the physical transformation of the promotional materials outside the computer. Accordingly, Applicant submits that claims as amended are appropriate statutory matter.

### Claim Rejections Under 35 U.S.C. § 102

Applicant respectfully submits that Landau is not a reference that may be cited against the present application under 35 U.S.C. § 102(e). Section 102(e) indicates that an application filed in the United States before the invention by the Applicant for patent may act as prior art. A piece of art may be utilized under 102(e) if it has an effective filing date before the present application. The effective date of a U.S. Application may be determined as follows:

If the application is a continuation-in-part of an earlier U.S. application any claims in the new application not supported by the specification and claims as the parent application as an effective filing date equal to the filing date of the new application.

(MPEP 706.02). Landau is a continuation-in-part of application number 09/846,159 filed on May 1, 2001, which is a non-provisional of application number 60/201,041 filed on May 1, 2000. The present application has a filing date of March 10, 2001. Accordingly, for Landau to serve as § 102(e) prior art against the present application the information relied upon by the Examiner must have been disclosed in the provisional application 60/201,041 filed May 1, 2000. However, the information relied upon by the Examiner is new to Landau and cannot find support in application number 09/846,159 filed May 1, 2001, nor in the provisional application 60/201,041 from which it depends. Accordingly, Landau as cited against the present application has an effective filing date as of November 6, 2001. Because Landau's effective filing date occurs later in time than the filing date for the present application, Landau is not a reference that may be cited against the present application.

#### Claim Rejections Under 35 U.S.C. § 103

As noted above, Landau is not a reference that may not be cited against the present application. Accordingly, the rejections under 35 U.S.C. § 103(a) which depends upon Landau are inappropriate.




### CONCLUSION

Applicants submit that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicants request favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 5 day of July, 2005.

Respectfully submitted,

  
Michael F. Krieger  
Attorney for Applicant  
Registration No. 35,232

KIRTON & McCONKIE  
1800 Eagle Gate Tower  
60 East South Temple  
Salt Lake City, Utah 84111  
Telephone: (801) 321-4814  
Facsimile: (801) 321-4893

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